

REMARKS

Reconsideration and allowance of the subject application are respectfully requested.

Claims 23-31, 33-50, and 52-61 are pending.

On February 7, 2001 Applicants' representative conducted a personal interview with the Examiner regarding the art grounds of rejection. The Examiner has rejected claims 23-24, 26-31, 33-39, 42-43, 45-50, 52-57 and 59-61 under 35 U.S.C. §103 as being unpatentable over Yamagishi '008 in view of Enokida '393, and rejected claims 23-24, 27-31, 33-39, 42-43, 46-50, 52-57 and 59-61 under 35 U.S.C. §103 as being unpatentable over DeHaan in view of Enokida.

With respect to the art grounds of rejection, the Examiner has admitted that both Yamagishi '008 and DeHaan fail to disclose or suggest "each specific data includes the associated relative position data," and "each of the relative position data ... indicative of a plurality of relative positions from a current nth specific data location to each of a n+1, n+2, ..., n+m specific data location, where m is greater than 2," as recited in claim 23. However, the Examiner argued that Enokida teaches the above-quoted features of claim 23, and that one skilled in the art would have combined the teachings of Enokida with Yamagishi.

Applicants' representative asserted that Enokida discloses with respect to Fig. 8 a moving image processing apparatus including a first disk 125 and a second disk 122. As disclosed in column 11, lines 5-17, the second disk 122 stores administrative information 60 corresponding to the moving image data 65 stored by the first disk 125. As shown in Fig. 10, the administrative information stored in disk 122 includes offset data identifying the position of intra-frames in the moving image data. As taught in column 12 of Enokida, during a fast playback mode, the offset data in the second disk 122 is used to access the intra-frame data in the first disk 125 for reproduction.

Applicants representative further reminded the Examiner that during the Examiner Interview on January 11, 2000, the Examiner agreed Enokida teaches that the moving image data and the administrative data corresponding thereto are stored separately. Therefore, as agreed during the Interview on January 11, 2000, Enokida not only fails to disclose or suggest "each specific data includes the associated relative position data," recited in claim 23, but also would motivate one skilled in the art to separately store the administrative and moving image data. Consequently, assuming one skilled in the art would have combined the teachings of Enokida with Yamagishi or DeHaan, the resulting art combination would have the administrative data stored separately from the moving image and fail to disclose or suggest "each specific data includes the associated relative position data," as recited in claim 23.

During the February 7, 2001 interview, the Examiner stated that in his view, one skilled in the art could have combined the teachings of Enokida with Yamagishi '008 or DeHaan such that instead of separately storing the administrative data from the image data, the administrative data could be stored as part of the image data.

Applicants' representative asserted that the Examiner's position failed to consider the teachings of Enokida as a whole, and that the Examiner was impermissibly picking and choosing teachings of Enokida without considering Enokida's teachings as a whole in an attempt to reconstruct the claimed invention. The Examiner stated he was unaware of any requirement that the teachings of a prior art reference be considered as a whole. Accordingly, applicants' representative offered to submit this second reply after final providing the necessary case law support for applicant's position.

In Panduit Corp. v. Dennison Manufacturing Co., 227 U.S.P.Q. 337, 344 (Fed. Cir. 1985), *vacated and remanded on other grounds*, 229 U.S.P.Q. 478 (1986) the Federal Circuit stated:

The well established rule of law is that each prior art reference must be evaluated as an entirety, and that all of the prior art must be evaluated as a whole. See *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 727 F.2d at 1550, 220 U.S.P.Q. at 311; *In re Kuderna*, 426 F.2d 385, 390, 165 U.S.P.Q. 575, 578-79 (CCPA 1970).

And, in Bausch & Lomb v. Barnes-Hind/Hydrodcurve, 230 U.S.P.Q. 416, 419 (Fed. Cir. 1986), the Federal Circuit stated:

As the former Court of Customs and Patent Appeals held:

It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art. *In re Wesslau*, 353 F. 2d 238, 241, 147 U.S.P.Q. 391, 393 (CCPA 1965); *see also In re Mercer*, 515 F.2d 1161, 1165-66, 185 U.S.P.Q. 774, 778 (CCPA 1975).

As demonstrated above, the Federal Circuit has directed that prior art references must be considered as whole and that it is impermissible for the Examiner to pick and choose only so much of the reference as to support the Examiner's position and ignore other teachings necessary for a full appreciation of what the reference suggests.

As a whole, Enokida teaches providing administrative data for image data, and storing the administrative data separately from the image data. Consequently, when viewing Enokida as a whole, and assuming one skilled in the art would have combined Enokida with Yamagishi '008 or DeHaan, the combination of Enokida with Yamagishi '008 or DeHaan results in the administrative data being stored separately from the image data. Therefore, the

Yamagishi '008 or DeHaan in view of Enokida can not disclose or suggest "each specific data includes the associated relative position data," as recited in claim 23.

Applicants also respectfully request that the Examiner reconsider applicant's arguments presented in the previously filed reply that the Examiner has failed to supply a plausible motive for combining the teachings of Enokida with Yamagishi '008 or DeHaan (see bottom of page 3 – top of page 4 of the Reply filed January 19, 2001), and therefore, the Examiner has not established a prima facie case of obviousness and should withdraw these art grounds of rejection.

Independent claims 33, 42, 52 and 60 include similar limitations to those discussed above with respect to claim 23. Therefore, these claims are patentable at least for the reasons discussed above with respect to claim 23.

The remaining claims rejected based on Yamagishi '008 or DeHaan in view of Enokida are dependent on one of the above-discussed independent claims, and are therefore patentable at least for the reasons stated above with respect to those independent claims.

Applicants respectfully request that the Examiner withdraw these art grounds of rejection.

Claims 25 and 44 stand rejected under 35 U.S.C. §103 as being unpatentable over Yamagishi in view of Enokida and Naimpally. Also, claims

40-41 and 58 stand rejected under 35 U.S.C. §103 based on Yamagishi in view of Enokida and the Examiner's Official Notice. Applicants respectfully traverse these art grounds of rejection.

From even a cursory review of Naimpally and the Examiner's Official Notice, it is readily apparent that Naimpally and the Examiner's Official Notice do not overcome the disclosure and suggestion deficiencies of Yamagishi with respect to independent claims 23, 33, 42, 52 and 60. These claims are patentable over Yamagishi in view of Naimpally and Yamagishi in view of the Examiner's Official Notice. As such, claims 25, 44, 40-41 and 58, dependent upon on one of the independent claims, are at least patentable for the reasons stated above with respect to these independent claims.

Applicants respectfully request that the Examiner withdraw this art grounds of rejection.

Claims 25 and 44 stand rejected under 35 U.S.C. §103 as being unpatentable over DeHaan in view of Naimpally, and claims 26, 40-41, 45 and 58 stand rejected under 35 U.S.C. §103 as being unpatentable over DeHaan in view of the Examiner's Official Notice. Applicants respectfully traverse this art grounds of rejection.

From even a cursory review of Naimpally and the Examiner's Official Notice, it is readily apparent that Naimpally and the Examiner's Official Notice do not overcome the disclosure and suggestion deficiencies of DeHaan with

respect to independent claims 23, 33, 42, 52 and 60. These claims are patentable over DeHaan in view of Naimpally and DeHaan in view of the Examiner's Official Notice. As such, claims 25-26, 40-41 and 44-45, dependent upon on one of the independent claims, are at least patentable for the reasons stated above with respect to these independent claims.

Applicants respectfully request that the Examiner withdraw this art grounds of rejection.

Applicants note with appreciation the Examiner's indication that claims 1-22 are allowed.

In view of the above, it is believed that this application is in condition for allowance. A favorable action in the form of a Notice of Allowance is earnestly solicited.

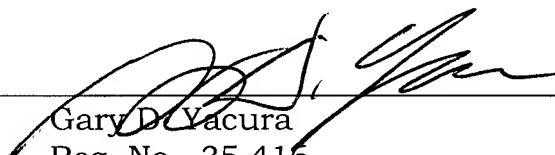
In the event that any outstanding matters remain in this application, Applicant requests that the Examiner contact Gary D. Yacura (Reg. No. 35,416) at (703) 205-8071 to discuss such matters.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Very truly yours,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By


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